

REMARKS

Claims 1-28 remain in the application. Claims 1 and 16 have been amended. The title has been amended. The specification has been amended. The drawings have been amended. New drawings have been submitted. Reconsideration of this application, as amended, is respectfully requested.

Claims 1 and 16 have been amended to specify that at least one reagent incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode. Support for this amendment can be found at page 4, line 24 through page 5, line 6 of the specification, and in FIGS. 1 and 2.

Support for these changes finds authority in In re Wertheim, 191 USPQ 90 (CCPA) 1976) at 97, wherein it is stated:

.....That what appellants claim as patentable to them is /ess than what they describe as their invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. As we said in a different context in In re Saunders, 58 CCPA 1316, 1327, 44F F. 2d 599, 607, 170 USPQ 213, 220 (1971):

To rule otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed. Cf. In r Ruff, 45 CCPA 1037, 1049, 256 F. 2d 590, 597, 188 USPQ 340, 347 (1958). Since the patent law provides for the amendment during prosecution of *claims*, as well as the specification supporting claims 35 USC 132, it is clear that the reference to "particularly pointing out and distinctly claiming the subject matter which the

applicant regards as his invention” in the second paragraph of 35 USC 112 does not prohibit the applicant from changing what he “regards as the invention” (i.e., the subject matter on which he seeks patent protection) during the pendency of his application.....

Claims 1 and 16 have been further amended to correct certain informalities.

The specification has been amended to conform to the replacement drawings.

The title of the application was objected to. The title has been amended at the suggestion of the Examiner.

The drawings were objected to under 37 CFR 1.83(a). Corrected drawings are being submitted herewith. In addition, new drawings are also being submitted. FIG. 2 has been replaced by FIGS. 2A and 2B. These drawings clearly show the flow channel 30 is configured to provide flow of liquid by means of capillary attraction. FIG. 7, a new drawing, shows a biosensor having an electrode arrangement consisting of four electrodes, which both covers an electrode arrangement having both a reference electrode and a counter electrode and an electrode arrangement having a trigger electrode. FIG. 8, a new drawing, shows a biosensor having a layer of mesh for promoting flow of liquid to the electrodes.

Claim 16 was objected to because two components were designated with the same part number. This informality has been corrected.

Claims 5 and 20 were rejected under 35 U. S. C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1 and 16 were rejected under 35 U. S. C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 - 28 were rejected under 35 U. S. C. § 102 (b) as being anticipated by U. S. Patent No. 6,299,757 to Feldman et al. This rejection is respectfully traversed for the following reasons.

Feldman et al., U. S. Patent No. 6,299,757 (hereinafter "Feldman et al."), discloses a sensor utilizing a non-leachable or diffusible redox mediator. The sensor includes a sample chamber to hold a sample in electrolytic contact with a working electrode, and in at least some instances, the sensor also contains a non-leachable or a diffusible second electron transfer agent. The sensor produces a sensor signal in response to the analyte that can be distinguished from a background signal caused by the mediator.

Claims 1 and 16 have been amended to specify that at least one reagent is incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode or the electrical contact associated with the working electrode. Feldman et al. does not disclose or suggest that at least one reagent incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode or the electrical contact associated with the working electrode. In Feldman et al. the reagents are deposited over the electrodes only. Claims 2-15 depend either directly or indirectly from claim 1. Claims 17-28 depend either directly or indirectly from claim 16. Accordingly, this ground of rejection should be withdrawn.

Claims 1 - 4, 10, 12, 13, and 15 were rejected under 35 U. S. C. § 102 (b) as being anticipated by U. S. Patent No. 6,129,823 to Hughes et al. This rejection is respectfully traversed for the following reasons.

Hughes et al., U. S. Patent No. 6,129,823 (hereinafter "Hughes et al."), discloses an electrochemical sensor electrode strip that measures analyte concentration in an aqueous sample as small as 2.5 to 2.0 microliters. Reduction in the minimum sample size is achieved by means of dielectric coating impregnated into peripheral regions of one or more hydrophilic mesh layers, thereby reducing sample dead volume. The mesh layers are located between an electrode support and a cover layer, which cover layer includes an aperture located upstream from an electrode arrangement.

Claim 1 has been amended to specify that at least one reagent incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode or the electrical contact associated with the working electrode.

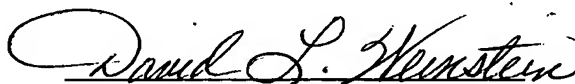
Hughes et al. does not disclose or suggest that at least one reagent incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode or the electrical contact associated with the working electrode. In Hughes et al. the reagents are deposited over the electrodes only. Claims 2 - 4, 10, 12, 13, and 15 depend either directly or indirectly from claim 1. Accordingly, this ground of rejection should be withdrawn.

In view of the foregoing, it is submitted that claims 1-28, as amended, are in condition for allowance, and official Notice of Allowance is respectfully requested.

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Abbott Laboratories
D-377 AP6D-2
100 Abbott Park Road
Abbott Park, Illinois 60064-3500
Telephone: (847) 937-6182
Fax. No.: (847) 938-2623

Respectfully submitted,
Robin D. Pierce, et al.

A handwritten signature in cursive script, reading "David L. Weinstein".

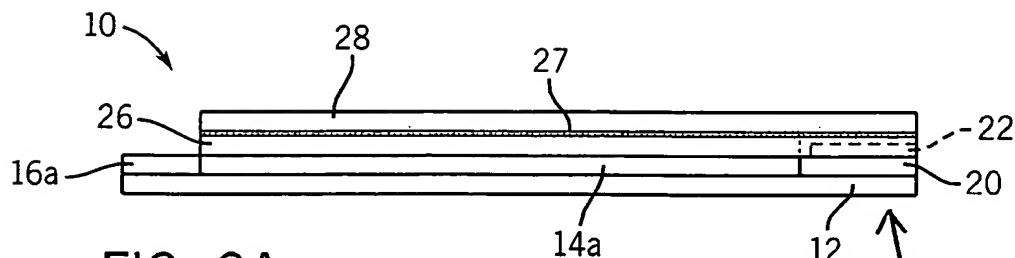
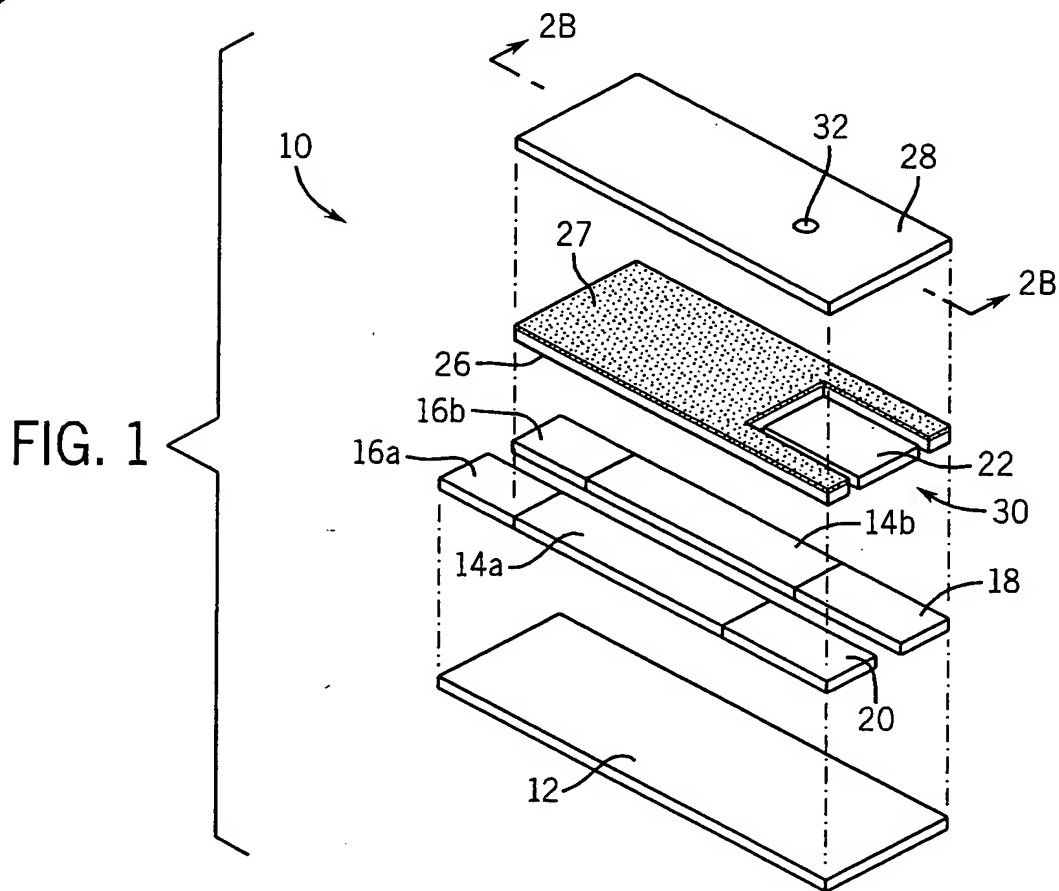
David L. Weinstein
Registration No. 28, 128
Attorney for Applicants

Amendments to the Drawings:

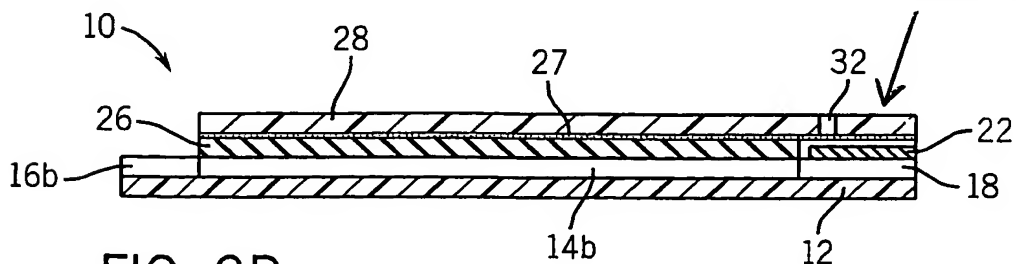
The attached sheets of drawings include deletion of FIG. 2 and substitution of FIG. 2 by FIG. 2A and FIG. 2B. In FIG. 2A and FIG. 2B, the capillary channel is shown more clearly by means of a dashed line in FIG. 2A and a section in FIG. 2B. The attached sheets of drawings include addition of FIG. 7 and FIG. 8. In FIG. 7, a trigger electrode 40 has been added, and the dual - purpose reference/counter electrode has been replaced by a separate reference electrode 36 and a separate counter electrode 34. The working electrode has been numbered as 38. In addition conductive tracks 14c, 14d, 14e, and 14f and electrical contacts 16c, 16d, 16e, and 16f have been added and numbered. In FIG. 8, a layer of mesh 40' has been added between the two substrates 12a' and 12b' and in the vicinity of the electrodes 18' and 20'.



1 / 5



Markings added to show
capillary flow channel



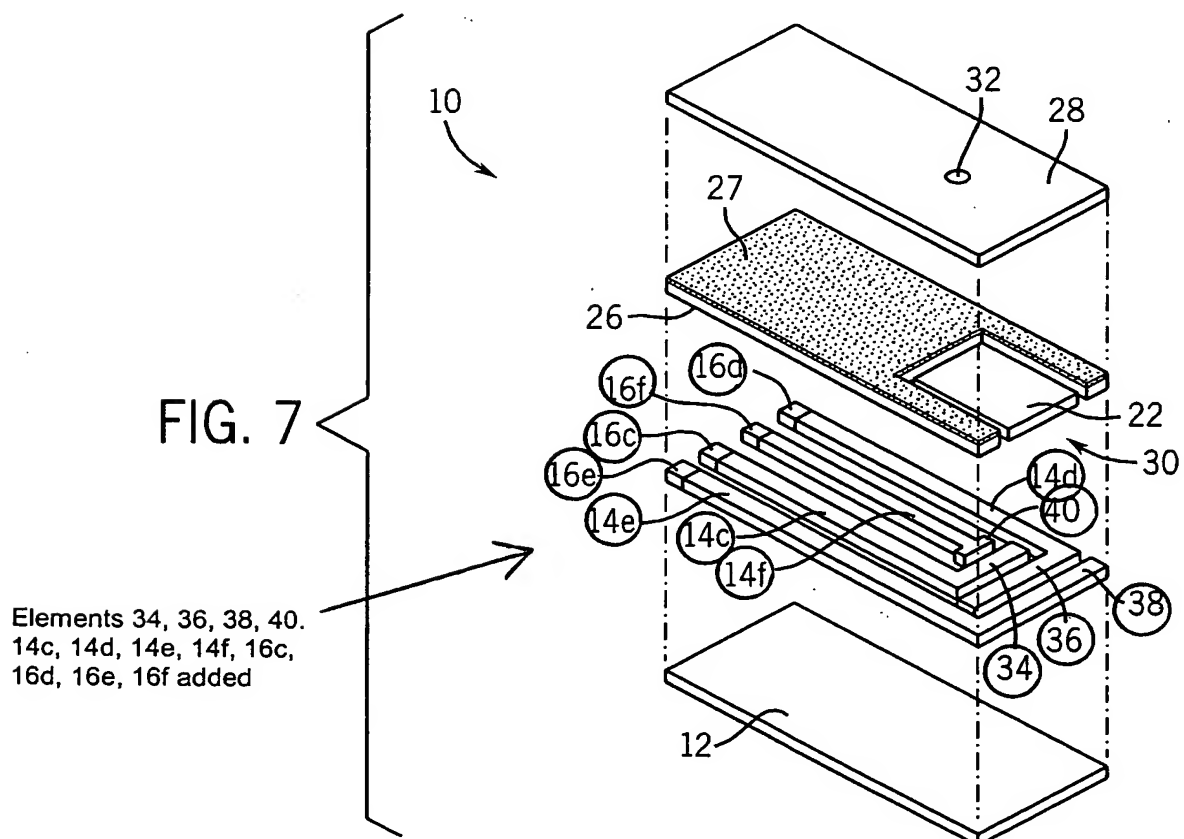
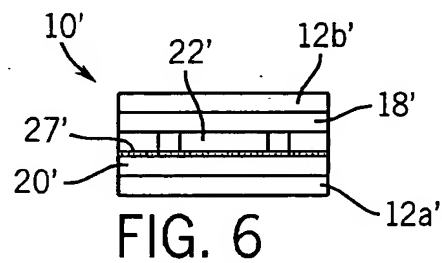
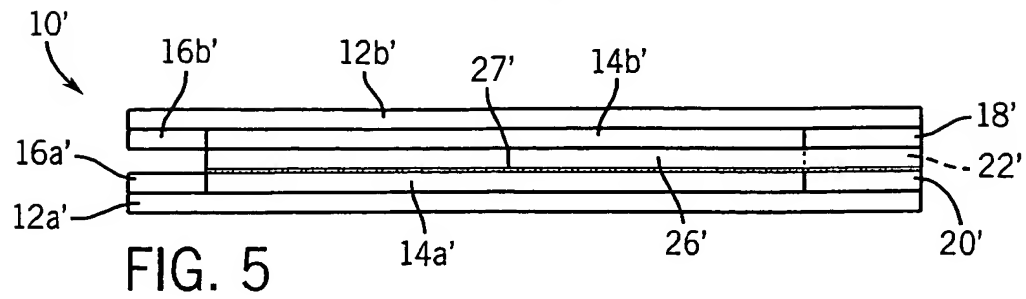
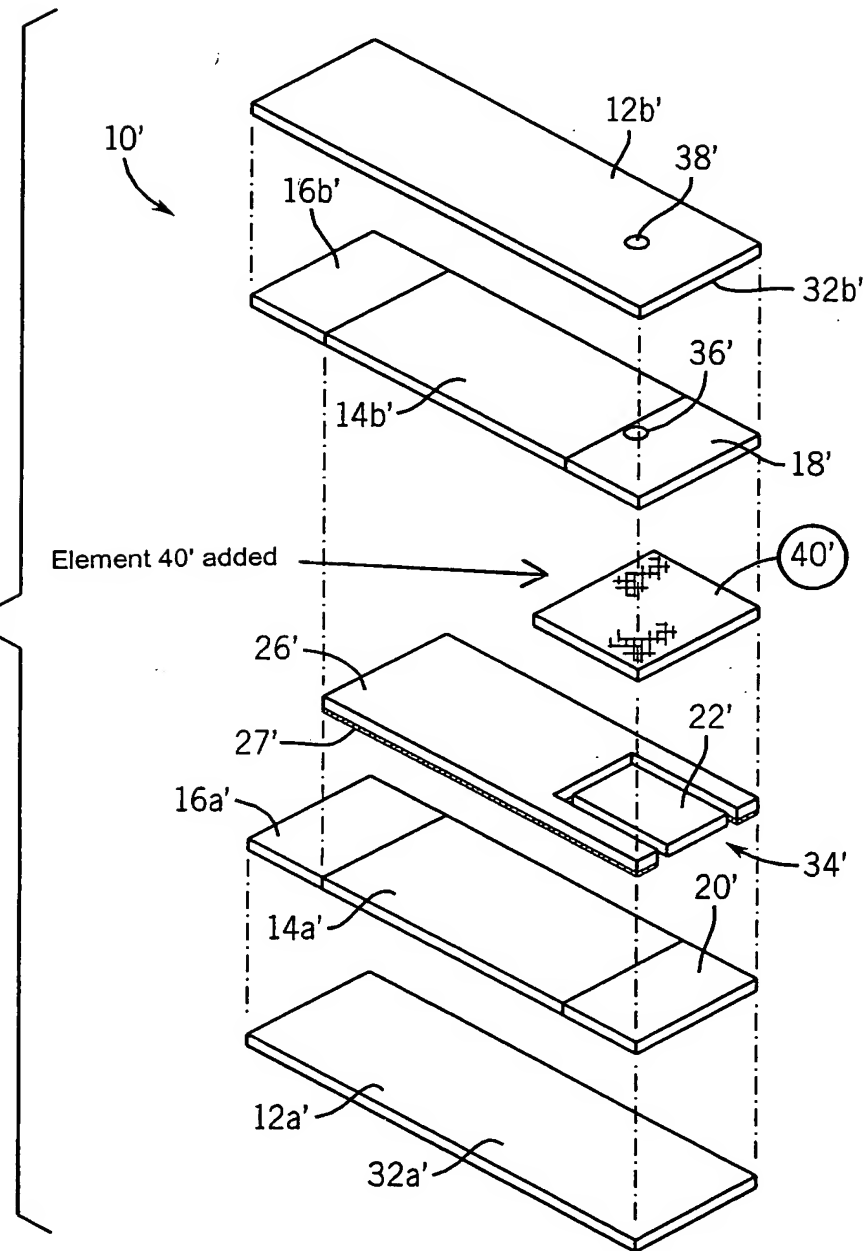
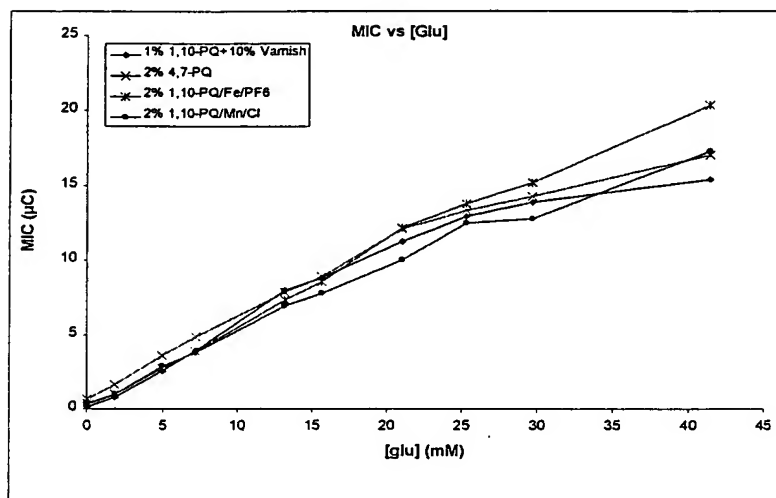


FIG. 8





Renumbered figure

→ FIG. 9